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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,240	08/24/2001	John W. Davies	38190/206669	2206
826	7590	06/15/2004	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000				TORRES, MELANIE
ART UNIT		PAPER NUMBER		
		3683		

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/939,240	DAVIES ET AL.
	Examiner	Art Unit
	Melanie Torres	3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12, 19 and 20 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4-9,11,12,19 and 20 is/are rejected.
- 7) Claim(s) 3 and 10 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 4, 6-9, 11, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speakman in view of Tohzuka and Bhatia et al.

Re claims 1, 7, 19 and 20, Speakman teaches a bearing assembly comprising a pair of bearing members (12, 32) movable relative to one another, the pair including a first member (12) and a second member (32) that define a space therebetween.

(Column 1, lines 5-13, Figure 1) However, Speakman does not teach wherein at least the first member having a bearing surface having a relatively thin coating of a PTFE-based material thereupon and a grease lubricant occupying the space defined between the first member and the second member, wherein the PTFE-based material and the grease lubricant act in conjunction with one another to lubricate the first and second members. Tohzuka discloses a PTFE-based material in a grease medium wherein the PTFE-based material and the grease lubricant act in conjunction with one another.

(Column 3, lines 1-7, Column 4, lines 22-34) It would have been obvious to have used the lubricant of Tohzuka in the assembly of Speakman so as to provide improved sliding surfaces between the two components. It is the examiner's position that, as claimed,

the first member is readable as having a PTFE-based material and the grease material as is the second component although it is a mixed material in the lubricant of Tohzuka. Further, it would have been obvious to have used a coating including a thermosetting stabilizer material as taught by Bhatia et al. in order to reduce thermal degredation in high temperature applications. (Column 13, lines 43 – Column 14, line 5)

Re claims 2, 8 and 9, Speakman as modified teaches wherein the coating is a PTFE-based material having a solid particulate in a form selected from the group consisting of flocked, powdered, fibrous, flaked, or beaded. (Column 4, lines 22-34)

Re claims 4 and 11, Speakman teaches wherein the first member (12) is formed from the group consisting of steel, titanium, aluminum, nickel, bronze and alloys thereof. (Column 1, lines 5-7)

Re claim 6, Speakman teaches wherein the coating is a self-lubricating material.

3. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speakman in view of Tohzuka and Bhatia et al. and further in view of Lee.

Re claims 5 and 12, Lee teaches sliding bearing comprising a seal (84) positioned in the space defined between first and second members. It would have been obvious to have included a seal in the assembly of Speakman as modified so as to reduce the amount of debris that would interfere with the operation of the bearing.

Allowable Subject Matter

4. Claims 3 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed March 15, 2004 have been fully considered but they are not persuasive.

Applicant argues that Speakman does not teach or suggest a PTFE-based material. The examiner acknowledges this as discussed in the rejection of the claims under 35 USC 103.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applicant argues that there is no motivation to combine the teachings of Tohzuka with the teachings of Speakman. A motivation was given in the rejection above (also included in the previous office action). It is well known in the art that a liquid that includes a PTFE component

has an improved reduction in friction among the components as these combinations are commonly used in a variety of applications.

Applicant states that “the PTFE-based material cited in the present claims is not a grease, such as the grease disclosed by Tohzuka.” Applicant’s second paragraph clearly states “a grease lubricant.”

In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., the specific definition of “thermosetting stabilizer”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). With regard to the “thermosetting stabilizer,” though applicant indicated that the stabilizer of Bhatia et al. was used in PTFE for a reason other than the stabilizer of Applicant, there is no support in the specification indicating the specific meaning of “thermosetting stabilizer.” Therefore, the “heat stabilizer” taught by Bhatia et al. is deemed to be readable on applicant’s limitation.

In response to applicant’s argument that the heat stabilizer is used to regulate the application of heat during manufacture of PTFE particles, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Further, Applicant noted that "no recent patents were found with the terms "PTFE" and "thermosetting stabilizer." The examiner noted that in addition to being undefined in the specification, the term "thermosetting stabilizer" does not even exist in the electronic database. It is well known that different terms for the same limitations are commonly used in applications. Therefore, this argument is moot.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Torres whose telephone number is (703)305-0293. The examiner can normally be reached on Monday-Friday, 6:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on (703)308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT
June 8, 2004

Robert A. Siconolfi 6/10/04
ROBERT A. SICONOLFI
PATENT EXAMINER